REMARKS

Claims 1-20 are pending in the present application. In view of the remarks which follow, reconsideration is respectfully requested.

Incomplete Office Action

Applicant's first Information Disclosure Statement (IDS) was filed on November 13, 2000. Applicant is enclosing a copy of an acknowledgment post card which bears the date stamp of the PTO mailroom, and which shows that the first IDS was in fact received by the PTO.

The pending Office Action was issued more than two years after the PTO received the first IDS, but does not reflect consideration of the first IDS, and is therefore incomplete. In this regard, Applicant respectfully directs the attention of the Examiner to MPEP §609(III)(C)(2), which specifically recognizes that Applicant is not required to use Form PTO-1449. This section of the MPEP states that: "If the citations are submitted on a list other than on a form PTO-1449 or PTO/SB/08A and 08B, the examiner may write 'all considered' and his or her initials to indicate that all citations have been considered". Thus, although Applicant's first IDS did not use Form PTO-1449, the Office Action should have been accompanied by an initiated copy of the sheet which lists the documents that were cited in the first IDS.

Since the Office Action does not indicate that the Examiner considered the first IDS on the merits, the Office Action is incomplete. In this regard, the attention of the Examiner is respectfully directed to the provisions MPEP §609, §609(III)(B)(1) and §609(III)(C)(2), which make it clear that,

when an IDS complies with the provisions of 37 C.F.R. §§1.97 and 1.98, the Examiner is required to consider the IDS before issuing the next communication on the merits, and the next communication must be accompanied by an initialed copy of the applicant's "list" of documents. Since the present Office Action did not include an initialed copy of the list from the first IDS, the Office Action is incomplete. Consequently, the Examiner's next communication on the merits will technically be the first proper communication on the merits, and should be a non-final action which is accompanied by an initialed copy of the list of documents from Applicant's first IDS.

Second paragraph of 35 U.S.C. §112

In the Office Action, at lines 6-15 on page 2, the Examiner rejects Claims 1-20 under the second paragraph of 35 U.S.C. §112, asserting that these claims are indefinite because they each include the word "different". In particular, the Examiner asserts that the word "different" is a relative term, and therefore renders Claims 1, 4, 7 and 14 indefinite. This §112 rejection is respectfully traversed, for the following reasons.

First, there is no good basis for the assertion that the word "different" is a "relative" term. In this regard, the provisions of MPEP §2173.05(b) discuss various terms which the PTO considers to be "relative" terms that could potentially be indefinite. The word "different" does not appear among the various terms which are discussed there. The Examiner has not offered any support whatsoever for the assertion that "different" is a word which is routinely regarded by the PTO as a "relative" term.

The Examiner then goes on to assert: (1) that the word "different" is not defined in the claims, (2) that the specification does not provide a standard for ascertaining the requisite degree, and (3) that one of ordinary skill in the art would not reasonably understand the scope of the invention. The Examiner's statement on this point uses only standard "boilerplate" language, and does not contain a single word which is specific to the context of the claims that appear in the present application. In fact, the entire §112 rejection lacks a single word of explanation as to why, in the specific context of Claims 1, 4, 7 and 14, the word "different" might somehow present some indefiniteness. The Examiner basically assumes that the word "different" is automatically indefinite whenever it is used in a claim, but that assumption is contrary to standard PTO practice.

Further, it should be noted that the rejection is based on the occurrence of "different" at line 3 in each of Claims 1, 4, 7 and 14, but no objection has been raised to other occurrences of the word "different" in the claims, for example at line 5 of Claim 7 and line 6 of Claim 14. Consequently, it is respectfully submitted that the Examiner recognizes that the word "different" is not inherently indefinite. In order to establish that the word "different" is indefinite as used in line 3 of Claims 1, 4, 7 and 14, even though it is not regarded as indefinite at other locations, the Examiner would need to discuss the specific context of the use of "different" in line 3 of each of Claims 1, 4, 7 and 14, as mentioned above. But the entire §112 rejection lacks even a single word of explanation which is specific to the context of Claims 1, 4, 7 and 14. It is therefore respectfully

submitted that the Examiner has failed to carry the burden of establishing that indefiniteness is the result of the specific context within which the word "different" is used in line 3 of each of Claims 1, 4, 7 and 14.

For the foregoing reasons, it is respectfully submitted that there is no reasonable basis for the assertion that the word "different" is a relative term, and thus no basis for the assertion that Claims 1, 4, 7 and 14 are inherently indefinite because they happen to include the word "different". It is therefore respectfully submitted that Claims 1-20 are definite and comply with the second paragraph of §112, and notice to that effect is respectfully requested.

Double Patenting – Claims 1 and 4

The Office Action rejected Claims 1 and 4 under the judicially-created doctrine of obviousness-type double patenting, based on either Claim 1 or Claim 11 of co-pending U.S. Serial No. 09/658,239, when taken in view of Koppolu U.S. Patent No. 6,446,135. This ground of rejection is respectfully traversed, for the following reasons.

First, and as recognized in the Office Action, the double-patenting rejection is a _provisional_ rejection, because it involves two applications which are both still pending. Until one of the two applications is allowed and a patent issues, there is no actual double-patenting issue. The attention of the Examiner is respectfully directed to the provisions of MPEP §804(I)(B), which relate to this type of situation, and which essentially state that, when one of the two pending applications reaches a point where the only remaining rejection is a provisional double-patenting

rejection, the Examiner should withdraw the provisional double-patenting rejection in that application, and maintain a non-provisional double-patenting rejection in the second application. Consequently, if the present application reaches a point where the provisional double-patenting rejection is the only remaining ground of rejection, the Examiner should withdraw the double-patenting rejection.

Turning to the underlying basis for the double-patenting rejection, the Examiner notes that Claim 1 of the present application and Claim 1 of the '239 application have some similar limitations, but concedes that Claim 1 of the '239 application does not include a limitation comparable to the recitation in Applicant's Claim 1 of "wherein one of said function definitions identifies a separate application program, wherein one said function portion which corresponds to said one function definition identifies a command for said application program, and wherein execution of said one function portion causes execution of said command by said application program in a manner which affects data present in said one function portion". The Examiner asserts that, in view of the Koppolu patent, it would be obvious to add this limitation to Claim 1 of the '239 application.

In this regard, the Examiner asserts that Koppolu discloses an application program which has a function identifying a command in a manner that affects data in the function (at lines 30-40 of column 9, and lines 24-59 of column 14). Applicant respectfully disagrees. What Koppolu discloses is that a "caller" computer program can send to a "callee" computer program a communication which causes the callee program to execute a command. However, as discussed in

the portion of Koppolu which bridges columns 14-15, the callee program merely sends back a code which indicates whether or not the command was successfully executed. There is no teaching that the command executed by the callee affects data present in the caller. Consequently, the indicated portions of Koppolu disclose something different from the limitation of Applicant's Claim 1 which has been quoted above. Consequently, even if Claim 1 of the '239 Application is considered in view of the indicated portions of Koppolu, the result would not be the subject matter recited in Applicant's Claim 1.

A further consideration is that, in any obviousness analysis which involves a combination of teachings from two documents, the Examiner must not only propose how the teachings from the documents would be combined, but must also provide evidence that the prior art would motivate a person to make the proposed combination. (See MPEP §2143.01). In the present situation, the Examiner fails to do so. In particular, the Examiner merely makes the conclusory statement that "it would have been obvious to one skilled in the art to combine the recitation of the '239 application with the teaching of Koppolu thus enhancing the '239 application so that a set of different functions might be selected, depending upon the input to the system, and affect data by running the function in the application". It is not clear this sentence actually states a motivation for making the proposed combination, but even assuming that it does, the Office Action does not identify any specific portion of the prior art as the origin for this motivation. Instead, the origin for the motivation here is apparently a personal belief of the

Examiner, rather than anything found in the prior art. Consequently, in the absence of a clear explanation from the Examiner as to why there would be motivation which originates in the prior art, the obviousness analysis is incomplete and therefore defective.

Applicant also wishes to point out that an obviousness analysis in the context of a double-patenting rejection is not the same as an obviousness analysis for purposes 35 U.S.C. §103. As one aspect of this, the ultimate issue in a double-patenting rejection is whether two claims are both directed to essentially the same subject matter. Although Claim 1 of the present application and Claim 1 of the '239 application each include some limitations that are similar, they also each include some other limitations which are radically different. For example, and as noted above, Claim 1 of the present application recites "wherein one of said function definitions identifies a separate application program, wherein one said function portion which corresponds to said one function definition identifies a command for said application program, and wherein execution of said one function portion causes execution of said command by said application program in a manner which affects data present in said one function portion". In contrast, Claim 1 of the '239 application includes a recitation of "transmitting through a communications link from a first end thereof to a second end thereof a communication from a user which causes one of storing and execution of the project definition at said second end of the communications link". When these radically different limitations are taken into account, it is respectfully submitted that Claim 1 of the present application

and Claim 1 of the '239 application are not even remotely directed to the same basic subject matter, but instead are each directed to significantly different subject matter.

For the reasons set forth above, it is respectfully submitted that Claim 1 of the present application and Claim 1 of the '239 application are directed to respective different inventions, and that this remains true even if Claim 1 of the '239 application is considered in view of Koppolu patent. It is therefore respectfully submitted that the double-patenting rejection of Applicant's Claim 1 should be withdrawn.

Turning to Claim 4 of the present application, the double-patenting rejection thereof is based on Claim 11 of the '239 application when considered in view of the Koppolu patent, based on essentially the same rationale discussed above in association with Applicant's Claim 1. Therefore, and for reasons similar to those discussed above in association with Applicant's Claim 1, it is respectfully submitted that Applicant's Claim 4 is directed to an invention which is different from the invention recited in Claim 11 of the '239 application, even when Claim 11 of the '239 application is considered in view of Koppolu. It is therefore respectfully submitted that the double-patenting rejection of Applicant's Claim 4 should be withdrawn.

Double Patenting - Claims 7 and 14

The Office Action rejected Claims 7 and 14 under the judicially-created doctrine of obviousness-type double-patenting, based on either Claim 1 or Claim 11 of co-pending U.S. Serial No. 09/658,239, when taken in view of Davis U.S. Patent No. 6,002,876. This ground of rejection is

respectfully traversed, for the following reasons. First, as recognized in the Office Action, this double-patenting rejection is a <u>provisional</u> rejection, because it involves two applications which are both still pending. Therefore, and for reasons discussed above, when the present application reaches a point where the provisional double-patenting rejection is the only remaining objection, the Examiner should withdraw it.

Turning to the underlying basis for the double-patenting rejection, the Examiner notes that Claim 7 of the present application and Claim 1 of the '239 application have some similar limitations, but concedes that Claim 1 of the '239 application does not include a limitation comparable to the recitation in Applicant's Claim 7 of "modifying said set to include at least one custom function definition which is functionally different from each of said predetermined function definitions". The Examiner asserts that, in view of the Davis patent, it would be obvious to add this limmitation to Claim 1 of the '239 application.

In this regard, the Examiner asserts that Davis teaches the modification of a set of functions (at lines 15-61 of column 4). Applicant respectfully disagrees. The indicated portion of Davis is simply talking about the fact that two or more segments of source code can each be converted into object code using either a compiler program or an assembler program, and that a linker program can then be used to link the resulting segments of object code into a single executable program. In short, the indicated portion of Davis discusses a compiler, an assembler and a linker, but does not disclose any specific source code or specific object code, much less any specific segments of code which represent a set

of predetermined function definitions, still less any specific segment of code which represents a custom function definition. The assertion in the Office Action that "Davis teaches the modification of a set of functions" represents the use of hindsight of the present invention. Consequently, even if Claim 1 of the '239 application is considered in view of the indicated portions of Davis, the result would not be the subject matter recited in Applicant's Claim 7.

A further consideration is that, as discussed earlier, when any obviousness analysis involves a combination of teachings from two documents, the Examiner must not only propose how the teachings from the documents would be combined, but must also provide evidence that the prior art would motivate a person to make the proposed combination. In the present situation, the Examiner fails to do so. In particular, the Examiner merely makes the conclusory statement that "it would have been obvious to one skilled in the art to combine the recitation of the '239 application with the teaching of Davis to allow modification of the function set with additional functions, or updating existing functions, thus extending the utility of the project definition by providing an efficient means of upgrading the functions". It is not clear that this sentence actually states a motivation for making the proposed combination, but even assuming that it does, the Office Action does not identify any specific portion of the prior art which is the origin of this motivation. Instead, the origin for motivation here is apparently a personal belief of the Examiner, rather than anything found in the prior art. Consequently, in the absence of a clear explanation from the Examiner as to why there would be

motivation which originates in the prior art, the obviousness analysis is incomplete and therefore defective.

Applicant also wishes to point out that, as mentioned earlier, an obviousness analysis in the context of a double-patenting rejection is not the same as an obviousness analysis for purposes of 35 U.S.C. §103. As one aspect of this, the ultimate issue in a double-patenting rejection is whether two claims are both directed to essentially the subject matter. In this regard, and as noted above, Claim 7 of the present application recites "modifying said set to include at least one custom function definition which is functionally different from each of said predetermined function definitions". In contrast, Claim 1 of the '239 application recites "transmitting through a communications link from a first end thereof to a second end thereof a communication from a user which causes one of storing and execution of the project definition at said second end of the communication link". When these radically different limitations are taken into account, it is respectfully submitted that Claim 7 of the present application and Claim 1 of '239 application are not even remotely directed to the same basic subject matter, but instead are each directed to significantly different subject matter.

For the reasons set forth above, it is respectfully submitted that Claim 7 of the present application and Claim 1 of the '239 application are directed to respective different inventions, and that this remains true even if Claim 1 of the '239 application is considered in view of the Davis patent. It is therefore respectfully submitted the double-patenting rejection of Applicant's Claim 7 should be withdrawn.

Turning to Claim 14 of the present application, the double-patenting rejection thereof is based on Claim 11 of the '239 application when considered in view of the Davis patent, based on essentially the same rationale discussed above in association with Applicant's Claim 7. Therefore, and for reasons similar to those discussed above in association with Applicant's Claim 7, it is respectfully submitted that Applicant's Claim 14 is directed to an invention which is different from the invention recited in Claim 11 of the '239 application, even when Claim 11 is considered in view of Davis. It is therefore respectfully submitted that the double-patenting rejection of Applicant's Claim 14 should be withdrawn.

Independent Claim 1 - 35 U.S.C. §103

Independent Claim 1 stands rejected under 35 U.S.C. §103 as obvious in view of a combination of teachings from Mukherjee U.S. Patent No. 6,226,322 and the Koppolu patent. This ground of rejection is respectfully traversed, for the following reasons.

The primary reference in this rejection is the Mukherjee patent. Figure 1 of Mukherjee discloses hardware circuitry which includes three modems 8 and 15, the modem 8 being coupled to each of the modems 15 by a respective twisted wire pair (TWP). Generally speaking, the Examiner asserts that the modem circuitry shown in FIGURE 1 of Mukherjee corresponds to the "project definition" recited in Applicants' Claim 1, including a plurality of function portions, a further portion and binding information. However, Applicant's Claim 1 includes a recitation that "execution of said one function

portion causes execution of said command by said application program in a manner which affects data present in said one function portion". The hardware circuitry shown in Figure 1 of Mukherjee does not have any function portion which is capable of being "executed", nor does it appear to have any function portion capable of causing execution of a command in a software application program in a manner which affects data present in the hardware. Consequently, the hardware circuitry shown in Figure 1 of Mukherjee is not a "project definition" which is comparable to the "project definition" recited in Applicant's Claim 1. Therefore, since the §103 rejection relies on Mukherjee for the disclosure of a project definition having certain characteristics, and since Mukherjee does not actually disclose a project definition with these characteristics, the §103 rejection necessarily fails.

The Examiner asserts that the defects in the hardware circuitry in Mukherjee can be cured by modifying the Mukherjee circuitry in view of the software program disclosed in Koppolu. This assertion is respectfully traversed. First, it is respectfully submitted that it would not be obvious to combine teachings from Mukherjee regarding hardware with teachings from Koppolu regarding software. It is respectfully submitted that there would be nothing obvious about attempting to modify the disclosed hardware circuitry in view of the disclosed software program, particularly in view of the fact that the hardware circuitry includes one or more modems and the software program has absolutely nothing to do with modems.

Moreover, even assuming that the indicated teachings from Mukherjee could somehow be combined with the indicated teachings from Koppolu, the result would not be the subject

matter of Applicant's Claim 1. In particular, and as discussed earlier, Koppolu teaches that a caller program sends to a callee program a communication which causes the callee program to execute a command and then return a code which indicates whether or not the command was executed successfully. There is no teaching in Koppolu that the command affects any data within the caller program. In contrast, Applicant's Claim 1 recites that a "function portion causes execution of said command by said application program in a manner which affects data present in said one function portion". This is different from what is taught in Koppolu, consequently, this feature would not be obvious, even if the indicated teachings of Mukherjee are considered in light of the indicated teachings of Koppolu.

Still another consideration is that, as discussed earlier, a proper obviousness analysis under §103 must include not only a proposed combination of Mukherjee and Koppolu, but must also (1) establish motivation for making the proposed combination, and (2) establish that the motivation has its origin in the prior art. In the Office Action, the §103 rejection of Claim 1 merely offers a conclusory statement that a person of ordinary skill would make the proposed combination. The Office Action does not establish any solid motivation for making this combination, much less establish that there is motivation which has its origins in the prior art.

For the reasons discussed above, it is respectfully submitted that there are several flaws in the §103 rejection of Claim 1, and that Claim 1 is not rendered obvious under §103 by Mukherjee, considered by itself or in commbination

with Koppolu. Claim 1 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 4 - 35 U.S.C. §103

Independent Claim 4 stands rejected under 35 U.S.C. §103 as obvious in view of a combination of teachings from Mukherjee and Koppolu. The rationale given in the Office Action for this rejection is identical to the rationale given for the §103 rejection of Claim 1. Therefore, for the same basic reasons discussed above in association with Claim 1, it is respectfully submitted that Claim 4 is not obvious under §103 in view of Mukherjee and Koppolu. Claim 4 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 7 - 35 U.S.C. §103

Independent Claim 7 stands rejected under 35 U.S.C. §103 as obvious in view of a combination of teachings from the Mukherjee and Davis patents. This ground of rejection is respectfully traversed, for the following reasons.

The primary reference in this rejection is the Mukherjee patent. As discussed earlier, Figure 1 of Mukherjee discloses hardware circuitry which includes three modems 8 and 15, the modem 8 being coupled to each of the modems 15 by a respective twisted wire pair (TWP). Generally speaking, the Examiner asserts that the modem circuitry shown in FIGURE 1 of Mukherjee corresponds to the "project definition" recited in Applicants' Claim 7, including a plurality of function portions, a further portion and binding information. However, Applicant's Claim 7 includes a recitation of "modifying said

set [of predetermined function definitions] to include at least one custom function definition which is functionally different from each of said predetermined function definitions". The Examiner has taken the position that Mukherjee has predetermined function definitions which are each embedded in a respective portion of the hardware circuitry. But this means that making a modification to implement a custom function definition would essentially involve the design and fabrication of a new hardware component. The indicated portions of Mukherjee do not appear to include anything which contemplates the design and fabrication of new hardware circuitry. It is thus respectfully submitted that, even assuming Mukherjee discloses a "project definition", it is not comparable to the "project definition" which is recited in Applicant's Claim 7. Therefore, since the §103 rejection relies on Mukherjee for the disclosure of a project definition, and since Mukherjee does not actually disclose a project definition which is comparable to that recited in Claim 1, the §103 rejection necessarily fails.

The Examiner asserts that the defects in Mukherjee can be cured by modifying Mukherjee in view of teachings from Davis. As discussed earlier, the indicated portions of Davis are limited to a discussion of software programs, and in particular focus on a compiler program, an assembler program, and a linker program. It is respectfully submitted that it would not be obvious to combine Mukherjee and Davis, because there is no reasonable way to modify the hardware modem circuitry shown in the indicated portion of Mukherjee based on the pure software programs disclosed in the indicated portions

of Davis, especially since the complier, assembler and linker programs have absolutely nothing to do with modems.

Even assuming that it would somehow be possible to combine the indicated teachings from Mukherjee with the indicated teachings from Davis, the result would not be the subject matter of Applicant's Claim 7. In particular, as discussed above, the indicated portion of Davis is focused on compiler, assembler and linker programs, and does not disclose anything that could reasonably be considered to be a specific set of predetermined function definitions, much less the concept of modifying a set of predetermined function definitions so as to include at least one custom definition which is functionally different from each of the predetermined function definitions. Consequently, it is respectfully submitted that the subject matter of Claim 7 would not be obvious, even if the hardware modem circuitry of Mukherjee is considered in light of the software complier, assembler and linker programs of Davis.

Still another consideration is that, as discussed earlier, a proper obviousness analysis under §103 must include not only a proposed combination of Mukherjee and Davis, but also must (1) establish motivation for making the proposed combination, and (2) establish that the motivation has its origin in the prior art. In the present Office Action, the §103 rejection of Claim 7 merely offers a conclusory statement that a person of ordinary skill would make the proposed combination. The Office Action does not establish any solid motivation, much less that there is motivation which has its origin in the prior art.

For the reasons discussed above, it is respectfully submitted there are several flaws in the §103 rejection of Claim 7, and that Claim 7 is not rendered obvious under §103 by Mukherjee and Davis. Claim 7 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 14 - 35 U.S.C. §103

Independent Claim 14 stands rejected under 35 U.S.C. §103 as obvious in view of a combination of teachings from Mukherjee and Davis. The rationale given in the Office Action for this rejection is identical to the rationale given for the rejection of Claim 7. Therefore, for the same basic reasons discussed above in association with Claim 7, it is respectfully submitted that Claim 14 is not obvious under §103 in view of Mukherjee and Koppolu. Claim 14 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2-3 and Claims 5-6, Claims 8-13 and Claims 15-20 respectively depend from Claim 1 and Claim 4, Claim 7 and Claim 14, and are also believed to be allowable over the art of record, for example for the same reasons discussed above with respect to Claims 1, 4, 7 and 14, respectively.

Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore

respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (214) 953-6684.

Respectfully submitted,
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